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| 10/527,876 | 03/16/2005 | Ronald George Yates | MP-003 | 2042 |
| 38051 | 7590 | 03/28/2006 | EXAMINER | |
| KIRK HAHN 14431 HOLT AVE SANTA ANA, CA 92705 | | | NGUYEN, SON T | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3643 | |

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/527,876

Applicant(s)

YATES ET AL.

Examiner

Son T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/16/05 & 1/26/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 3-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 6-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

SON T. NGUYEN
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/20/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 3-5 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species II, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/26/06.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show reference numerals 134,150 as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "164" has been used to designate raised outer rim, radially outer wall of inner rim and lip. Reference character "160" has been used to designate inner rim and lip. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 11,15,23 & 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For claim 11, "said inner rim" lacks prior antecedent basis. For claim 15, "the toe clip core" lacks prior antecedent basis. For claim 23, it is unclear as to what is "aluminium aluminum". For claim 24, "said layer of rigid material" lacks prior antecedent basis.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1,2,6-12,15-19,24** are rejected under 35 U.S.C. 102(b) as being anticipated by Hasegawa (6116346).

For claim 1, Hasegawa teaches a horseshoe comprising a core 12 of rigid material sandwiched between first 17 and second 18 layers of shock absorbing material, at least one of the first and second layers being bonded to the core at a face where the core has a plurality of indentations 13.

For claim 2, Hasegawa teaches the indentations are dished depressions.

For claim 6, Hasegawa teaches the elastomeric material in the first layer is a different thickness to the elastomeric material in the second layer (see fig. 6, ref. 18 is thicker than ref. 17).

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For claim 7, Hasegawa teaches the elastomeric material in the first layer has a different composition to the elastomeric material in the second layer (col. 2, lines 29 & 37-39).

For claim 8, Hasegawa teaches the core comprises an upper face; a lower face; a curved inner wall (any one of the wall inside the shoe is considered inner wall) extending between the upper and lower faces; a curved outer wall (any one of the wall outside or near the peripheral edge of the shoe is considered outer wall) between upper and lower faces; the inner and outer walls blending at heel portions of the shoe (those walls at the heel area); and the lower face having a raised rim (from the lower face where ref. 15 is pointing at, the raised rim is where any one of ref. 14 is pointing at) adjacent the inner wall, a raised rim (from the lower face where ref. 15 is pointing at, the raised rim is where any one of ref. 14 is pointing at) adjacent the outer wall, and a plurality of ridges (the material linking the recesses 13) linking the rims, such that the rims and ridges in combination form depressions therebetween which are at least substantially filled with elastomeric material.

For claim 9, Hasegawa teaches the rim adjacent the inner wall and the rim adjacent the outer wall are joined at the heels of the lower face by continuations of the rims which sweep around the heels on the lower face. Any one of the recess 13 walls 14,15.

For claim 10, Hasegawa teaches the ridges are aligned substantially transverse to the rims where the ridges meet the rims. Any one of the recess 13 walls 14,15.

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For claim 11, Hasegawa teaches each ridge extends from about the crest of the inner rim to about the crest of the outer rim. Any one of the recess 13 walls 14,15. The crest is the flat part.

For claim 12, Hasegawa teaches the depressions have an approximately rectangular or trapezoidal appearance from the lower face.

For claim 15, Hasegawa teaches a toe clip 21 upstanding from the toe of the shoe, wherein the core has integrally formed therewith a toe clip core portion 16 which rises from the toe perpendicular to the layers and wherein the upper portion of the toe clip projects further forwards from the toe than is the lower portion of the toe clip core.

For claim 16, Hasegawa teaches the shoe having an upper face; a bottom face; a curved inner wall extending between the upper and bottom faces; a curved outer wall between the upper and bottom faces; the inner and outer walls blending at heel portions of the shoe, and the bottom face having a raised rim adjacent the inner wall and a raised rim adjacent the outer wall. Any one of the walls 14,15 of the recess 13 can be considered inner and outer wall and raised rims.

For claim 17, Hasegawa teaches wherein a plurality of ridges link the rims such that the raised inner rim, raised outer rim and the linking bridges in combination form indentations therebetween. Any one of the walls 14,15 of the recess 13 can be bridges or the material between recesses 13.

For claim 18, Hasegawa teaches wherein the linking ridges are aligned substantially transverse to the rims where the ridges meet the rims. The material between recesses 13 and walls 14,15.

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For claim 19, Hasegawa teaches the indentations appear approximately rectangular or trapezoidal when viewed perpendicular to the bottom face.

For claim 24, Hasegawa teaches wherein a hard insert 23 is anchored into the rigid material and protrudes into one of the first and second layers.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 13-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa (as above) in view of Bergeleen (6263973).

Hasegawa is silent about the core has, around its toe portion, the outer rim raised to a greater extent than the inner rim.

Bergeleen teaches a horseshoe with a core which has an outer rim raised to a greater extent than the inner rim, with ridges (see figs. 3-4). In addition, the crests of the ridges are sloped from the inner rim to the outer rim. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ an outer rim raised to a greater extent than the inner rim, with ridges having crests that sloped from the inner rim to the outer rim as taught by Bergeleen in the horseshoe of Hasegawa in order to reduce strain on the horse's hoof (see Summary of Bergeleen).

10. **Claims 20-23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa (as above).

For claims 20-21, Hasegawa is silent about the elastomeric material being a polyurethane or a thermoplastic urethane bonded to the rigid material in an injection molding process. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the elastomeric material of Hasegawa out of polyurethane or a thermoplastic urethane, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious choice. In addition, injection molding is a notoriously well known process in the art for bonding horseshoe layers together. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the injection molding process to bond the thermoplastic urethane to the rigid material in the horseshoe of Hasegawa, since injection molding is a well known process of bonding horseshoe layers together.

For claim 22, Hasegawa is silent about the layers being made out of the same elastomeric material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have both first and second layers of Hasegawa be the same material, depending on the user's preference for his/her intended use.

For claim 23, the core of Hasegawa is a rigid material but not an aluminum based alloy. Aluminum based alloy is notoriously well known in the art of horseshoe. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the core of Hasegawa be made out of aluminum alloy, since it has been held to be within the general skill of a worker in the art to select a


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known material on the basis of its suitability for the intended use as a matter of obvious choice.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is 571-272-6889. The examiner can normally be reached on Mon-Thu from 10:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Son T. Nguyen
Primary Examiner
Art Unit 3643

stn